

## **REMARKS**

Currently claims 1-74 remain in the application. Claims 1-74 are rejected. Applicant believes no new matter has been added.

### ***Rejections under 35 U.S.C. § 103***

Claims 1-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrie USP 5,980,384 in view of Coelho et al USP 5,466,866.

Barrie describes a gaming apparatus that allows wagering on a game of chance. Barrie is silent in regards to how its displayed graphics are generated. Coelho describes graphical techniques including the use of sprites. Coelho is silent in regards to wagering type gaming machines and games, such as slot games.

All pending claims describe limitations such as, "storing to the memory device specifications for a plurality of sprites including a sprite for simulating a slot reel used in a game of chance," and "generating a motion of the slot reel for the game of chance on a display coupled to the gaming device using the sprite." Barrie doesn't describe how its graphics are generated. Thus, Barrie can't be said to teach or suggest these limitations. Coelho doesn't describe slot machines or in particular, generating a motion of the slot reel using a sprite.

Applicant believes Examiner has not established a case of *prima facie* obviousness for among other reasons the Examiner has not provided any prior art citation that "suggest the desirability of the combination." MPEP 2143.01 Suggestion or Motivation To Modify the References [R-3], section III states,

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

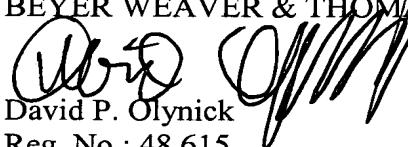
In the combination suggested by the Examiner, the invention of Barrie is being modified. Examiner states “*Barrie teaches the utilization of a video display for the simulation of a traditional reel slot machine game including the animated spinning of the game reels*” and “*Barrie is silent regarding the utilization of sprites to the described animation.*” For the desirability of the modification, Examiner states that “*it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized sprites as taught by Coelho as the animation means in the invention of Barrie in order to employ a common animation technique or alternatively to allow the creation of visual animation without requiring a reloading of the entire display.*”

Applicant believes that the statement “to employ a common animation technique” is not acceptable reasoning for establishing a desirability of the combination as is well noted in the MPEP. Examiner ‘s other suggestion for the modification of Barrie is “to allow the creation of visual animation without requiring a reloading of the entire display.” As Examiner admits this motivation is not taught in Barrie. Application searched for this motivation in Coelho and could not locate it. For instance, in Coelho, the term “reloading” is not found. Applicant requests that the Examiner cite a prior art source of the desirability of the combination that the Examiner is using, such as one found in Coelho or another prior art reference so that Applicant may properly refute it.

The motivation suggested by the Examiner is found in Applicant’s “Detailed Description of the Invention,” as an advantage of Applicant’s invention. Applicant believes that using Applicant’s submission to suggest a desirability of a modification is not a proper basis for establishing a *prima facie* case of obviousness. Applicant believes it is possible that Examiner’s reasoning may fall under “hind sight” reasoning as described in the MPEP. Therefore, for at least these reasons, the combination of Barrie and Coelho can’t be said to render obvious the claims of the present invention and the rejection of claims 1-74 is believed overcome thereby.

Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,  
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